

REMARKS

Claims 1-22 are pending upon entry of this amendment. Claims 1-4, 6, 8-11, 13 and 15 have been amended and new claims 16-22 have been added. No new matter has been added.

Claims 1, 8 and 15 are rejected under 35 USC 112, first paragraph, as failing to comply with the enablement and written description requirements. The Examiner states that these claims recite that the first job includes a template, but the specification does not disclose how the job itself includes the template. Claims 1, 8 and 15 have been amended to recite that the first job is *associated with* the first template. As shown in Fig. 3 of this application, a job may be associated, for example, with a template embedded in the file name. Claims 1, 8 and 15 are therefore enabled and fully supported by the specification. Withdrawal of these rejections is respectfully requested.

Claims 3 and 10 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that claims 3 and 10 recite that a job comprises serial numbers set for over a plurality of the files, but this feature is inconsistent with the requirement of independent claims 1 and 8 that the job include the template. Claims 3 and 10 have been amended to recite “the first template comprises serial numbers set for the first file.” This feature is consistent with amended independent claims 1 and 8. Withdrawal of this rejection is respectfully requested.

Claims 4 and 11 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that claims 1 and 8 recite that the template indicates that the file is to be merged, but claims 4 and 10 recite that the same template includes a first symbol indicating that a file contained in the job is stored and a second symbol indicating that all stored files are printed. Claim 4 has been amended to recite “the template determination section is further configured to determine whether the first file associated with a third template comprising at least one of a first symbol indicating that the first file is to be temporarily stored in the storage section or a second symbol indicating that files temporarily stored in the storage section are to be

merged and printed.” Claim 10 has been similarly amended. As shown in Fig. 3, a file may be associated with first template (e.g., the first row), a second template (e.g., the third row), or a third template comprising at first symbol (e.g., the fourth row) indicating that the first file is to be temporarily stored or a second symbol (e.g., the fifth row) indicating that all the stored files are to be printed. Accordingly, claims 4 and 10 are fully supported by the specification. Withdrawal of this rejection is respectfully requested.

Claims 1, 8 and 15 are rejected under 35 USC 112, first paragraph. The Examiner states that specification provides inconsistent definitions for the claimed “template.” Claims 1, 8 and 15 have been amended to recite that each of the first and second files is associated with a separate template indicating that that file is to be merged. The templates processed together refer to an instruction set for the first and second jobs merged together and printed according to specified rules, as discussed in paragraphs [0041] and [0042] of the specification. Accordingly, the specification is fully consistent with the claims. Withdrawal of this rejection is respectfully requested.

Claims 1, 7-8 and 14-15 are rejected under 35 USC 103(a) as being unpatentable over Catt. Claims 2-5 and 9-12 are rejected under 35 USC 103(a) as being unpatentable over Catt in view of Dimperio and/or Kuntz. Claims 6 and 13 are rejected under 35 USC 1039a) as being unpatentable over Catt in view of Suzuki. These rejections are respectfully traversed.

Claim 1, as amended, recites “a template determination section configured to determine, upon reception of a first job including a first file to be printed, whether or not the first job is associated with a first template which is provided to the first job and indicates that the first file is to be merged, and upon reception of a second job including a second file to be printed, whether or not the *second job is associated with a second template* which is provided to the second job and indicates that the second file is to be merged” (emphasis added). This feature is not disclosed or suggested by Catt.

In Catt, an imposition template 100 is generated to exhibit various information for placement of page images including single page image 90a and components pages 90b. Catt, para. [0057]. The Examiner asserts that the imposition template 100 of Catt corresponds to the claimed first job including a first file to be printed and that any one of the images 90a or 90b corresponds to the claimed second file included in a second job. The Examiner also asserts that imposition template 100 of Catt “is sent to produce a print output, thus, it may be called a print job as it is sent for such a job.”

Given these assertions, Catt fails to disclose or suggest determining whether or not the *second job is associated with a second template* which is provided to the second job and indicates that the second file is to be merged, as required by claim 1. Specifically, Catt’s system does not perform a determination as to whether the any of the images 90a, 90b (i.e., what the Examiner refers to as a second file included in a second job) is associated with a second template other than the imposition template 100. The only template in Catt indicative of whether and how the images 90a, 90b are to be merged is the imposition template 100. The images 90a, 90b are not associated with a second template separate from the imposition template 100. This arrangement in Catt has a disadvantage that all the images 90a, 90b must have been prepared before the imposition template 100 can be generated for placement of the images 90a, 90b in a single sheet.

In contrast to Catt, the claimed invention requires that determinations be made as to whether the first job is associated with a first template and the second job is associated with a second template, each template being indicative that the associated job is to be merged. The claimed invention therefore allows for individual files to be associated with separate templates, thus allowing the user to designate the files for merger in advance even if some of the files to be merged have not yet been prepared. See para. [0049] of the specification. Catt therefore fails to disclose or suggest the claimed invention.

Claim 1 is allowable for at least the foregoing reasons. Claims 8 and 15 recite similar features as claim 1 and are allowable for at least the same reasons. None of the additional cited references overcomes the deficiency of Catt discussed above. Accordingly, claims 2-7 and 9-14 are allowable at least for being dependent from an allowable independent claim.


New claims 16-22 are supported by, e.g., Fig. 2 of this application. Claim 16 is allowable because the cited art fails to disclose or suggest, among other things, "a job holding section configured to store the job in a storage section when it is determined by the template analysis section that the template is not the predetermined template," as recite in claim 16. Claims 16-22 are therefore allowable.

In view of the above, this application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **204552032100**.

Dated: September 14, 2009

Respectfully submitted,

By 
Amir Rohani
Registration No.: 61,782
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 400
McLean, Virginia 22102
(703) 760-7757